

Serial No.: 10/053,283

Attorney Docket No.: 01P19665US

**REMARKS**

Upon entry of the instant Amendment, Claims 1-5, 7-9, and 11-16 are pending. Applicant gratefully acknowledges that claims 5, 7, and 8 were allowed. Claims 1,-3 and 11-15 have been amended to overcome the Section 112 rejections. Claims 1, 2, and 9 have been amended to more particularly point out Applicants' invention.

Claims 1-4 and 11-16 were rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which was allegedly not enabling. In particular, the terms "vertically adjustable," "attachable" and "operable" were indicated to be non-enabling. Further, the term "capable of" was alleged to "not constitute a limitation in any patentable sense." The claims have been amended to recite "adjustably attached" or "moveably attached." However, Applicant respectfully notes that the Court of Appeals for the Federal Circuit has indicated that such limitations do, in fact, constitute limitations "in any patentable sense" and has stated that "it is improper to ignore all limitations that contain [e.g.] the phrase 'adapted to' or 'whereby' thereby reducing the claim to a collection of parts; the claims must be considered as a whole. *Pac-Tec, Inc. v. Amerace Corp.*, 903 F.2d 796, 14 U.S.P.Q.2d 1871 (Fed. Cir. 1990). As such, the Examiner is respectfully requested to reconsider and withdraw the rejection.

Claims 1, 2, and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes, U.S. Patent No. 5,754,622 ("Hughes") in view of Smith et al., U.S. Patent No. 6,282,264 ("Smith"). Applicants respectfully submit that the claimed invention is not taught, suggested, or implied by Hughes or Smith, either singly or in combination.

As discussed in the specification, a portal imaging device positioning apparatus according to an embodiment of the present invention includes a portal imaging device positioner attachable to a support such as a telescoping boom. The portal imaging device positioner is adapted to vertically adjust an imaging panel in a either a treatment or dosimetry mode to receive radiation that has passed through a body in the patient plane for measuring patient exit dosimetry, and adjust the panel in a physics mode or characterization mode to receive radiation at the patient plane, for device

Serial No.: 10/053,283

Attorney Docket No.: 01P19665US

commissioning during treatment. Thus, claims 1 and 2 have been amended to recite

“wherein in said first mode said portal imaging device positioner maintains an imaging panel in position to receive radiation passing through a body maintained in a patient plane for measuring patient dosimetry during treatment, and wherein in said second mode portal imaging device positioner maintains said imaging panel to receive radiation substantially at said patient plane in a characterization mode for device commissioning for treatment.”

Similarly, claim 9 has been amended to recite “means for deploying an imaging panel in a first mode to receive radiation from said apparatus below a patient plane for device commissioning for treatment and in a second characterization mode at said patient plane for device commissioning for treatment.”

In contrast, as acknowledged in the Official Action, Hughes does not provide a “vertically-adjustable portal imaging device positioner...” Smith provides an x-ray detector 34 supported by an arm 30/112 for use in a diagnostic system. Neither reference, however, relates to a “portal imaging device positioner [that] maintains said imaging panel to receive radiation substantially at said patient plane in a characterization mode.” As noted above, Hughes provides an essentially fixed device; thus, Hughes does not even appear to recognize the desirability of positioning the device in a patient plane for device characterization. Smith relates merely to a diagnostic imaging system and thus has nothing to do with characterization of a system for treatment or for delivering a treatment. As such, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims.

Serial No.: 10/053,283

Attorney Docket No.: 01P19665US

For all of the above reasons, Applicants respectfully submit that the application is in condition for allowance, which allowance is earnestly solicited.

Respectfully requested,

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